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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/655,886
Filing Date: September 06, 2000
Appellant(s): HIRKA ET AL.

MAILED

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GROUP 3600

Ce Li
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 7, 2006 appealing from the
Office action mailed November 17, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|--------|--------|
| 5,644,727 | ATKINS | 7-1997 |
| 6,226,623 | SCHEIN | 5-2001 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins (US Patent 5,644,727) in view of Schein et al. (US Patent 6,226,623, hereafter Schein).

Re. Claims 1 & 24, Atkins discloses a system and method for processing electronic transactions, comprising:

- a first interface to at least one cash account against which charges incurred through use of a linked account instrument are drawn (Col. 42, II. 53-58), including the automatic sweep feature (Atkins teaches an expert sweeps function to execute a client's financial affairs – Abstract, II. 17-20; Col. 7, II. 42-45; Coll. 8, II. 43-44, and to effect automated transactions (Fig. 1-14; Col. 9, II. 38-39; Col. 10, II. 1-5; Col. 13, II. 30-34; Col. 29, 3-25; Col. 42, II. 47-53, 60-63, including debit card, credit card, Smart Cards™, electronic checks, payroll debits and various other transaction facilities. The linked accounts are obviously inferred since the features disclosed by Atkins could not operate without linkage. However, Atkins does not explicitly state linked accounts, even though their use is obvious and essential because the account sweeps taught by Atkins

are part of Atkins' account linkage system. In the alternative, Schein further teaches a linked accounts system used by Citibank (Col. 4, ll. 45-56);

- a second interface to at least one credit account used to back up a cash account in the event of insufficient funds in the cash account to cover the charges incurred through the use of the linked account instrument (Abstract – ll. 17-21; credit facilities such as a Home Equity Loan facility, a line of credit, a credit card, including the operation of credit facilities – Col. 13, ll. 44-45; Col. 43, ll. 49-51. Col. 42, ll. 57-63. Atkins' basic system and method teaches at its core the principle of automated credit backup of cash transaction accounts . Further, Atkins teaches a wide variety of options which a financial institution and a customer can choose from (Title – “Operation and Management of One or More Financial Accounts .. for Exchange, Investment and Borrowing”, which encompasses the general purpose of financial institution services. For the financial Institution – Col. 7, ll. 48-50; Col. 11, ll. 3-5, 10-13, 18-23; For the Customer - Abstract, ll. 4-10). Atkins' rules options permit a customer user to choose any of or a combination of schemes for holding funds in one or more cash accounts, and/or for always having a zero balance in a cash account so that transactions drawn on such a cash account would always be funded by a designated credit instrument such as a points earning card, a home equity line of credit, and so forth. Interaction between the financial institution's policies and the customer user's preferences would have been obvious to an ordinary practitioner of the art; and
- (including claim 24 b)) an authorization server, communicating with the first interface and the second interface, the authorization server authorizing individual transactions against a pre-determined cumulative limit (Col. 34, ll. 9-11. It is a well known banking practice to sweep linked accounts once daily as part of a daily transaction cycle) on said at least one cash account, and performing sweeps of said at least one cash account at predetermined times (e.g. daily) to determine whether said at least one cash account contains sufficient funds to cover the charges incurred through use of the linked account

instrument. (Atkins teaches the operations of servers, and fault tolerant real time computer systems (Col. 1, ll. 23-27; Col. 11, ll. 54-59), and explicitly describes an authorization function (check authorization systems – Col. 10, l. 4). Atkins teaches the use of predetermined limits which are established by the account owner, beginning in the Abstract – ll. 20-30, and continued in Col. 34, ll. 9-11, through the rules feature which asks the user to establish rules such as how often or when to sweep the linked accounts and what transaction limits to impose on various accounts such as cash accounts and credit facilities. Such applications of Atkins' teaching would have been obvious from Atkins to an ordinary practitioner of the art at the time of Applicant's invention).

- Claim 24, a) interfacing to an authorization server to authorize individual transactions initiated through use of a linked account instrument against a predetermined cumulative limit on said at least one cash account (The options available to the customer user and their financial institution, and what would be suggested by traditional practices of banking institutions, would have made it obvious to the ordinary practitioner of the art to apply transaction limits to a cash account, such as a cumulative dollar limit over any specified period of time, such as a day, and/or a month).

Schein teaches that linked online transaction accounts were pioneered by Citibank in 1976 and 1977, including the linkage to a line of credit to back up a transaction account, such as a checking account (Col. 4, ll. 45-56). Schein discloses that such offerings proceeded to spread throughout the banking world in the ensuing years. Schein teaches the story of Citibank's continuing building upon this pioneering concept with increasingly sophisticated and flexible linked account offerings (Col. 5, ll. 6-57).

It would have been obvious to an ordinary practitioner of the art at the time of Applicants' invention to have combined the teachings of Atkins with the teachings of Schein in order to provide automated linked bank account facilities to customers to back up a cash account with a credit account in case of insufficient funds for a cash transaction in a cash account, and to make this automated back-up linkage work through the employment of an automated sweep feature operating at predetermined

times such as daily and/or monthly, and to have a server manage the authorization step according to predetermined rules. A motivation for this combination would have been to offer an improved integrated communications network that integrates customer information at a financial institution and makes this integration available from remote locations for the benefit of customers (Schein, Col. 7, ll. 43-46).

Re. Claims 2-23 & 25-49:

Re. Claim 2 & 25, Atkins teaches or suggests a system and method wherein said at least one cash account comprises at least one demand deposit account (Fig. 3 – A Demand Deposit Account is obvious).

Re. Claim 3 & 26, Atkins teaches or suggests a system and method wherein said at least one demand deposit account comprises a plurality of demand deposit accounts (Fig. 3; Col. 10, ll. 1-6; A Demand Deposit Account would have been an obvious option, especially since demand deposit accounts serve as a core transactional account for a large percentage of banking customers' accounts.).

Re. Claim 4 & 27, Atkins teaches or suggests a system and method of holding a cash account at any financial institution (Col. 27, line 56 – Col. 28. The cash account at any financial institution would have been an obvious option.).

Re. Claim 5 & 28, Atkins teaches or suggests a system and method of maintaining a plurality of credit accounts (Col. 27, line 56 – Col. 28, line 25; Col. 29, lines 3-25. The use of a plurality of credit accounts would have been an obvious option.).

Re. Claim 6 & 29, Atkins teaches or suggests a system and method of holding a credit account at any financial institution (Col. 27, line 56 – Col. 28, line 25; Col. 29, lines 3-25. The use of a plurality of credit accounts would have been an obvious option.).

Re. Claim 7 & 30, Atkins teaches or suggests a system and method of providing an associated credit line for said at least one credit account that is at least equal to the predetermined cumulative limit (Col. 29, lines 5-6. Establishing and maintaining a credit limit which is at least equal to the cumulative dollar limit established for overdrafts in the

demand account the credit facility backs up would have been an obvious option for a coordinated decision in the establishment and application of rules.).

Re. Claim 8 & 31, Atkins teaches or suggests a system and method, wherein the authorization server comprises an account information database, an account balance database, and a transaction history database (Col. 7, lines 27-30; Col. 28, line 66 – Col. 29, line 2).

Re. Claim 9 & 32, Atkins teaches or suggests a system and method of generating individual automated clearing house (ACH) debits for each transaction initiated with the linked account instrument, and authorized by the authorization server (Atkins teaches the well known ACH component of the banking system in Col. 3, TABLE 2-A1 and col. 5, TABLE 21-2 as the first line item under “Electronic” in each table, and financial institutions’ operation of the system – Col. 7, lines 47-53. ACH transaction information is an obviously available type of information to provide to a customer in this system.).

Re. Claim 10 & 33, Atkins teaches or suggests a system and method of processing the automated clearing house debits against a cash account via an automated clearing house (This is obvious in Atkins’s teaching since the system is to be operated by a financial institution such as a bank clear inter-bank debits through the ACH system they are part of - Col. 7, lines 47-53).

Re. Claim 11 & 34, Atkins teaches or suggests a system and method of processing the automated clearing house debits in the order in which they were generated (This FIFO method is an obvious rule to follow with ACH clearings in Atkins’ teaching due to bank operation of the system. Also, processing according to a predetermined set of rules is an obvious option in Atkins through the establishment of predetermined rules - Col. 7, lines 20-30.).

Re. Claim 12 & 35, Atkins teaches or suggests a system and method of processing each automated clearing house debit against a cash account based on the relative size of its amount (The rules based method of processing debits is well known to sometimes be based on the relative dollar size of the debits and would have been an obvious option to follow in a bank operation to clear ACH debits. Also, processing

according to a predetermined set of rules is an obvious option in Atkins through the establishment of predetermined rules - Col. 7, lines 20-30).

Re. Claim 13 & 36, Atkins teaches or suggests a system and method of processing the smallest debit amounts against a cash account first, leaving larger debits that cannot be satisfied by the cash account to be processed against a credit account (The ordinary practitioner would have found this as an obvious option, for example, in order to minimize the number of transaction charges for the employment of the credit back-up facility.).

Re. Claim 14 & 37, Atkins teaches or suggests a system and method of processing the largest debit amounts against said at least one cash account first, leaving smaller debits that cannot be satisfied by said at least one cash account to be processed against said at least one credit account (This option would have been obvious if the back-up transaction fees were based on the size of the of the back-up transaction such that the cumulative back-up transaction costs would be minimized in this manner.).

Re. Claim 15 & 38, Atkins teaches or suggests a system and method of processing an entire debit amount against a credit account in the event that there are funds in the cash account that can only cover a percentage of the debit amount (The ordinary practitioner would have found it obvious to establish this option in order to minimize the number of transactions over a series of days to minimize transaction costs or possibly serve other purposes).

Re. Claim 16 & 39, Atkins teaches or suggests a system and method of processing a first percentage of the debit amount against a cash account and a second percentage of the debit amount is processed against a credit account in the event that there are funds in the cash account that cannot satisfy the entire debit amount (This is another obvious variation of the ways debits can be managed. In this case the motive would be maximize the use of the funds available in a cash account and minimize the use of credit.).

Re. Claim 17 & 40, Atkins teaches or suggests a system and method wherein the predetermined cumulative limit is a daily limit (Daily limits n a transactional account

were well known and would have been obvious to the ordinary practitioner to consider offering).

Re. Claim 18 & 41, Atkins teaches or suggests a system and method of ceasing to authorize additional transactions attempted with the linked account instrument once the predetermined cumulative limit has been reached (This was also a well practice at the time of Applicant's invention. Atkins per establishment of predetermined rules; Abstract – lines 25-28).

Re. Claim 19 & 42, Atkins teaches or suggests a system and method of ceasing to authorize transactions attempted with the linked account instrument if a first sweep the cash account finds insufficient funds to satisfy previous charges incurred through use of the linked account instrument (This was another obvious option for the ordinary practitioner on the basis that a prior finding of insufficient funds can be used to bypass this account until a future event has occurred, such as a replenishment of funds to the account.).

Re. Claim 20 & 44, Atkins teaches or suggests a system and method of refreshing the predetermined cumulative limit and authorizing transactions after the credit account has been cleared (Atkins' rules system made this an obvious option for the ordinary practitioner).

Re. Claim 21 & 45, Atkins teaches or suggests a system and method of charging a user of the linked account instrument a fee for use of a credit account (Col. 11, lines 3-27, particularly suggested by line 16).

Re. Claim 22 & 46, Atkins teaches or suggests a system and method of continuing to cease authorization of transactions attempted with the linked account instrument if a predetermined number of subsequent sweeps of a cash account fail to find sufficient funds to satisfy the charges incurred through use of the linked account instrument (This is a well known past practice among banks; Abstract – lines 25-28).

Re. Claim 23 & 47, Atkins teaches or suggests a system and method of continuing to authorize linked account instrument transactions up to the predetermined cumulative limit against available credit on a credit account, even if a first sweep of said at least one cash account finds insufficient funds to satisfy previous charges (This practice or

rule is obvious on its face since it is only making use of a pre-established back-up credit facility).

Re. Claim 43, Atkins teaches or suggests a method further comprising the step of clearing a credit account if a subsequent sweep of a cash account finds adequate funds to satisfy those funds temporarily covered by the credit account (Atkins' rules system also made this an obvious option for the ordinary practitioner).

Re. Claims 48 & 49, Atkins teaches or suggests a system wherein an authorization server is configured to automatically withdraw funds from a cash account to cover at least part of the charges incurred through use of the linked account instrument (Cash account – an obvious suggestion in Col. 29, ll. 3-6; linkage - Column 9, ll. 32-39, Col. 10, ll. 1-10; real-time transaction processing - Col. 1, ll. 23-26. Further, banks have been known to follow this practice as a bank policy or to do so based on a prior agreement with the customer).

Therefore, re. Claims 2-23 & 26-49:

it would have been obvious to an ordinary practitioner of the art at the time of Applicants' invention to have combined the teachings of Atkins with the teachings of Schein and well known practices to provide automated linked bank account facilities to customers to back up a cash account with a credit account in case of insufficient funds for a cash transaction in a cash account, and to make this automated back-up linkage work through the employment of an automated sweep feature operating at predetermined times such as daily and/or monthly, and to have a server manage the authorization step according to predetermined rules. A motivation for this combination would have been to offer an improved integrated communications network that integrates customer information at a financial institution and makes this integration available from remote locations for the benefit of customers (Schein, Col. 7, ll. 43-46).

Re. Claim 50, Atkins discloses a method for accessing funds in at least one cash account, comprising the steps of:

- a) interfacing to an authorization server to authorize individual transactions initiated through use of an accounts sweep function instrument (Numerous

Interfaces are obviously in use in Atkins to permit the performance of many transactions in a linked accounts system and methods, and Atkins does occasionally make reference to interfaces, such as in Col. 42, II. 53-55. Atkins teaches an expert sweeps function to execute a client's financial affairs – Abstract, II. 17-20; Col. 7, II. 42-45; Coll. 8, II. 43-44, and to effect automated transactions (Fig. 1-14; Col. 9, II. 38-39; Col. 10, II. 1-5; Col. 13, II. 30-34; Col. 29, 3-25; Col. 42, II. 47-53, 60-63, including debit card, credit card, Smart Cards™, electronic checks, payroll debits and various other transaction facilities. The linked accounts are obviously inferred since the features disclosed by Atkins could not operate without linkage. However, Atkins does not explicitly teach linked accounts, even though their use is obvious and essential because the account sweeps taught by Atkins are part of Atkins' account linkage system. In the alternative, Schein further teaches a linked accounts system used by Citibank (Col. 4, II. 45-56); and

b) performing at least one automatic withdrawal from said at least one cash account to satisfy at least part of the charges incurred through use of the linked account instrument (Atkins teaches the use of checking accounts, money market accounts, certificates of deposit, which are all cash accounts with various limitations for use, and also the earning of employment income as the primary source cash (Col. 17 & 18, Tables 4 and 5). Further, Atkins teaches the various kinds of transactions in a person's financial activities (Col 28, I. 66 – Col. 29, I. 25.). Wages are included (Col. 29, I. 8. Additional transactions types taught by Atkins include interest, dividends and asset disposition. Transaction means include debit and credit card, Smart cards, ATM's and other means. Since it common practice to use checking accounts for transaction purposes, automatic withdrawals from at least one cash account would have been obvious features from Atkins to an ordinary practitioner of the art, since Atkins teaches a comprehensive financial account management system which includes incoming funds into a cash account, and the distribution of such funds among the user customer's other financial accounts according to the customer's personally chosen funds management rules and their interaction with the financial institution's account management rules).

Atkins does not explicitly disclose a predetermined cumulative limit on said at least one cash account. However, the options available to the customer user and their financial institution, and knowledge of the traditional practices by banking institutions, would have made it obvious to the ordinary practitioner of the art to apply transaction limits to presented to a cash account, such as a cumulative dollar limit over any specified period of time, such as a day, a week, or a month.

Re. Claim 51, Atkins discloses a system for processing electronic transactions, comprising:

- a first interface to at least one cash account against which charges incurred through use of a (Col. 9, II. 32-39; Col. 10, I. 4);
- a second interface to at least one credit account used to back said at least one cash account in the event of insufficient funds in said at least one cash account to cover the charges incurred through the use of the linked account instrument (Col. 7, II. 20-30; Col. 7, I. 66 – Col. 8, I. 10; Col. 10, II. 1-4; Col. 9, II. 32-39. Back-up of a cash account is an obvious option in the Atkins teaching); and
- an authorization server, communicating with the first interface and the second interface, the authorization server authorizing individual transactions against a pre-determined cumulative limit on said at least one cash account, performing sweeps wherein funds are withdrawn from said at least one cash account at predetermined times, and, if funds are not available from said at least one cash account, using the at least one credit account until the at least one cash account contains sufficient funds to cover the charges incurred through use of the linked account instrument (Atkins teaches the operations of servers, and fault tolerant real time computer systems (Col. 1, II. 23-27; Col. 11, II. 54-59; Col. 30, I. 62 – Col. 31, I. 7), and explicitly describes an authorization function (check authorization systems – Col. 10, I. 4). Atkins also teaches the use of predetermined limits which are established by the account owner, beginning in the Abstract – II. 20-30; Col. 7, II. 20-30, 42-45; Col. 8, II. 43-44).

Atkins does not explicitly disclose the use of linked account instrument. However, Schein teaches that linked online transaction accounts were pioneered by Citibank in 1976 and 1977, including the linkage to a line of credit to back up a transaction account, such as a checking account (Col. 4, ll. 45-56). Schein discloses that such offerings proceeded to spread throughout the banking world in the ensuing years. Schein teaches the story of Citibank's continuing building upon this pioneering concept with increasingly sophisticated and flexible linked account offerings (Col. 5, ll. 6-57).

It would have been obvious to an ordinary practitioner of the art at the time of Applicants' invention to have combined the teachings of Atkins with the teachings of Schein in order to provide automated linked bank account facilities to customers in order to back up a cash account with a credit account in case of insufficient funds for a cash transaction in a cash account, and to make this automated back-up linkage work through the employment of an automated sweep feature operating at predetermined times, and to have a server manage the authorization step according to predetermined rules. A motivation for this combination would have been to offer an improved integrated communications network that integrates customer information at a financial institution and makes this integration available from remote locations for the benefit of customers (Schein, Col. 7, ll. 43-46).

(10) Response to Argument

I. GENERAL RESPONSE:

- a)** Appellant's general theme throughout the arguments implies arguments based on an erroneous anticipation standard as if the rejections had been based on one of the 35 CFR 102 statutes through a parsing of words focused around the phrase "linked account instrument", while in fact all of the rejections are based on the 103(a) obviousness statute.
- b)** Appellant's specification provides a broad and flexible definition for the linked account instrument of Appellant's invention in the specification on page 6, lines 10-17: "A linked account instrument (not shown, for instance a magnetically encoded plastic card similar to a credit card or ATM card) may be provided to consumers to access

funds in an existing cash account 160 such as a DDA held at a financial institution, such as a bank or savings and loan, or other institution. Transactions may be initiated by swiping the linked account card at a point of sale (P.O. S.) terminal 110 when purchasing goods and/or services from merchants, or via other mechanisms such as telephone or Internet remote authorizations against the linked account card".

(Underlining added). A DDA is a Demand Deposit Account, such as a checking account.

c) It is important to note that Appellant's above definition is purposefully broad due to the open ended, many faceted components of this definition, as follows:

(1) a linked account instrument may "for instance" be "a magnetically encoded plastic card similar to a credit card or ATM card". In other words, it may be something else as well, such as another type of card or, as stated near the end of the definition, "other mechanisms such as telephone or Internet remote authorizations against the linked account card". This definition suggests that any means of access and authorization to the "linked account instrument" is intended, not just a magnetically encoded plastic card. This further suggests that the "linked account instrument" is not a physical device or instrument, nor an access method or mechanism, but a system which has a multifaceted method for making use of it.

(2) numerous specific uses are given as examples of open endedness:

* ... the card "may be provided to consumers to access funds in an existing cash account",

* ... the account to be accessed may be an account "such as a DDA held at a financial institution, such as a bank or savings and loan, or other institution". This leaves open the suggestion that it may be some other kind of account, such as a savings account, or even a credit facility such as a credit card account or a line of credit.

* Additional, broader uses are then suggested by the statement that "transactions may be initiated by swiping the linked account card at a point of sale (P.O. S.) terminal 110 when purchasing goods and/or services from merchants".

(3) To summarize, Appellant's "linked account instrument" is not a card but instead is what is generally known in the financial art as a linked accounts "facility", which

has been in broad computer automated use since the 1970's. It is the facility of linked accounts which Appellant is implicitly describing as being the invention.

- d) In fact, Appellant's "linked account instrument" is a linkage facility which had been in use without the efficiency of computer automation for generations, perhaps ever since the banking and financial services system came into existence, executed at the time through human labor involvement. This was the case when a bank honored a payment drawn against an overdrawn checking account because a back-up credit or loan facility had previously been explicitly approved for the particular customer, or just because a customer had a profile which made the bank comfortable with an informal honoring of a check when insufficient funds existed in the customer's checking account.
- e) The arrival of computer automation hardware and software merely created a predictable proliferation of the automation of existing financial services processes and policies and many permutations thereof, as an increasing amount of possibilities were recognized by the financial community over time and consumers went into a period of explosive growth in the use of these very convenient and efficient computer automation enabled financial facilities.
- f) Both Atkins and Schein disclose and suggest that the prior art had far surpassed Appellant's invention by beginning to offer Appellant's credit back-up facility to a cash account, and then adding many additional linkage and back-up facilities during the years leading up to Appellant's effective inventive date of September 6, 21000.
- g) Citibank, as revealed in Schein, introduced computer automated linked financial accounts to the world in the 1970's and continued to improve upon the art in the 1980's and 1990's.
- h) Atkins thoroughly, implicitly and by suggestion discloses many examples of the thorough use of linked accounts and of the related enabling feature of account sweeping or sweeps.
- i) Both Atkins and Schein, explicitly and implicitly, teach and suggest linked account instruments which enable and trigger the use and functioning of linked financial accounts of a wide variety.

- j) In both Atkins and Schein, magnetically striped cards are disclosed or suggested, as are a profusion of linked account facilities and instruments.
- k) A large variety of computer interfaces are essential and implicit throughout Atkins and Schein for the operation of their linked account facilities and instruments.
- l) Sweeps are also explicitly disclosed and often implicit in the disclosures of Atkins and Schein as they are essential for the operation of their linked account facilities and instruments.
- m) The ordinary practitioner at the time of Appellant's invention would have personally experienced the ubiquitous nature of linked account instruments throughout the consumer and commercial financial service industry.
- n) Appellant attempts to define his invention's "linked account instrument" as something patentably novel, despite the above evidence that Appellant's linked account instrument invention had been in wide public use by Citibank's customers and many others for approximately 15 years.
- o) It is clear that the ordinary practitioner of the art at the time of Appellant's invention would have seen every aspect of his invention as obvious not only from the disclosures and suggestions of Atkins and Schein, but even from being a consumer of these ubiquitous linked account services throughout the USA and much of the rest of the world.

II. DETAILED RESPONSE

A. SUMMARY ARGUMENT for the Allowability of Claims 1-51 (p. 8, l. 15 – p. 9, 2). Please see the full argument at the beginning of section VII. above of this Appeal Brief.

.– The rejection of claims 1-51 under 35 USC 103(a) is improper (p. 8, ll. 15-16) because the examiner has not met the burden of proof in establishing obviousness of the claimed invention (and thus has not met the requirements for establishing a *prima facie* case of obviousness).

RESPONSE: Appellant has quoted short selections from several court opinions which are convenient to his argument. The Federal Circuit has recently provided the following

clarification through the *In re Kahn* decision: "A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d at 1343-46; *Rouffett*, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. *See id.* at 1344-45." *In re Kahn*, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006). The recently ruling in *in re Kahn* supports this trend as well. Please note the following key guidelines provided above in *In re Kahn*: "A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d at 1343-46; *Rouffett*, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. *See id.* at 1344-45." *In re Kahn*, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

In this instance, the examiner has previously established in the record the requirements of the above "test for an implicit showing is what the combined teachings,

knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*". The examiner has met these requirements by providing extensive articulated reasoning and rational underpinning to support the legal conclusion of obviousness (See the rejection of claim 1, above.). The examiner has provided additional reasoning in the above GENERAL RESPONSE to demonstrate that Appellant's invention is little more than an obvious application of the prior art as that art is disclosed and suggested by Atkins and Schein. As such, the examiner has established in that record what the art of Atkins and Schein teach and suggest, what the knowledge of one of ordinary skill in the art was at the time of Appellant's invention, and what the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Further, the disclosures and suggestions in both Atkins and Schein solve the problems which Appellant seeks to solve through his invention. The motivation for the ordinary practitioner to combine references and make use of obviousness conclusions has been entered into the record several times by the examiner in the rejection of every claim and Appellant is not disputing the validity of these motivations for all of the independent claims and most of the dependent claims. The only argument for a lack of motivation to modify is in regard to dependent claims 2-3 and 25-26. However, the examiner has demonstrated valid motivation to modify Atkins in the record, in the rejections above, and in the response to arguments below regarding claims 2-3 and 25-26. Therefore, the examiner's conclusion is that a *prima facie* case of obviousness has been properly established in rejecting Appellant's claims 1-51.

ARGUMENT C. - Independent Claim 1 is patentable over Atkins and Schein

Argument C. 1. Neither Atkins Nor Schein Teaches or Suggests a "Linked Account Instrument" (p. 11, l. 20 – p. 15, l. 22).

RESPONSE: Appellant attempts to rebut the examiner's *prima facie* case by arguing about the lack of a "linked account instrument" with mere questions and allegations against Atkins (p. 11, l. 22 – p. 13, l. 9) and Schein (p. 13, l. 10 – p. 15, l. 22). Appellant also attempts to argue a narrow standard which would only apply to a 35 USC 102 rejection of anticipation. The examiner is unable to find a combination of reasoning and

evidence which reasonably satisfies Appellant's burden to disprove the examiner's *prima facie* case of obviousness regarding both references to demonstrate that the reasonableness of his allegation that neither Atkins or Schein neither teach or suggest a "Linked Account Instrument" within the standard of a *prima facie* case of obviousness.

Regarding Atkins, Appellant's summary of the argument regarding Atkins on p. 13, II. 1-9, not his buildup to it on page 12, fail to include any concrete rationale that Atkins fails to teach or suggest a linked account instrument as defined by Appellant in his specification. On the contrary, Appellant's definition of his "linked account instrument" is so broad that far lesser disclosures would satisfy valid prior art for an obviousness rejection.

Regarding Schein, Appellant again talks in circles around the subject as if attempting to disprove a 35 USC 102 rejection of anticipation without satisfying his burden to reasonably disprove the examiner's elaborately demonstrated case of obviousness. regarding Appellant's claimed and broadly defined "linked account instrument". Appellant used his right to be his own lexicographer to give a practical broad definition in the specification (see above) for his invention's "linked account instrument" in order to achieve practical acceptance in the market place. Unfortunately, the market place was already saturated at the time of Appellant's invention by prior art with a profusion of applications for the kind of "linked account instrument" Appellant has defined, the computer automated art therefor having already been approximately 25 years old at that time.

Argument C. 2. Neither Atkins Nor Schein Teaches or Suggests "a second interface to at least one credit account used to back said at least one cash account in the event of insufficient funds in said at least one cash account" (p. 15, II. 23-25).

RESPONSE: Appellant redefines this claim limitation as "the at least one credit account provides overdraft protection to the at least one cash account" (p. 15, II. 29-30). Appellant states on p. 16, II. 1-2 that "The Examiner does not contend that Schein discloses this limitation.". The examiner did not explicitly use Schein for rejecting this limitation because Atkins sufficiently discloses and suggests this limitation as

documented in the rejection of claims 1 and 24 above. The ordinary practitioner would see that Schein makes this feature completely obvious to see. It is even essential for the operation of such a feature in Schein since Schein does at the most fundamental level teach and suggest the providing of overdraft protection to cash accounts. After all, the providing of overdraft protection was one of the original features and purposes of the linked account instrumentality brought to the market place by Citibank, as disclosed by Schein. Consequently, Appellant's comment is disingenuous.

Appellant again launches into the kind of narrow parsing of detailed functionality which is inappropriate and unnecessary in a case of obviousness combination. Appellant's arguments again fail to rise to the standard of rational rebuttal and evidence required to call into question the examiner's detailed exposition and rationale for rejecting this limitation under the 35 USC 103(a) standard. For example, arguing that the examiner is confusing a "line of credit" with a "credit account" (p. 16, l. 5 - p. 17, l. 13) is contextually in error but also fails to make the needed case, since there is no practical difference between the use of the two related facilities of a line of credit and a credit account when it comes to the issue of Appellant's version of a "linked account instrument" and its operation and use in the context of the obviousness rejections in this application. Atkins teaches the sweeping of linked accounts and numerous implicit interfaces. On page 17, lines 11-12, Appellant includes an argument which has no bearing on the rejection of claims since the claim(s) do not involve distinctions of financial institutions, even though Atkins even offers the mixing of financial institutions to the user (Col. 9, ll. 29-32).

Appellant argues that "the Examiner fails to point out exactly which ... "variety of options" (in Atkins) covers the use of a credit account to back up a cash account as presently claimed'. First, this argument seems to have questionable relevancy in an obviousness scenario. However, Atkins teaches a user driven set of choices for linking accounts making use not only of the central feature of Atkins' invention, which has a variety of liabilities and leveraging based on an asset such as a home serving as security. But Atkins offers the wide variety of accounts, including cash accounts, credit accounts, credit cards, and linked account instrumentalities to be used by the user at the user's choice. Samplings of these disclosures are contained in Col. 7, ll. 41-44,

sweeping of accounts among asset and liability accounts is suggested in whatever manner the user may desire, with suggestions being offered by the system, a variety of accounts is suggested in Col. 7, lines 54-58, both asset - cash, savings, securities, real estate, etc. and liability accounts - secured loans, unsecured loans and lines of credit, credit cards, etc. Additional options for linked accounts are suggested in Col. 10, lines 1-10, including a mixture of asset and liability accounts (credit cards) with an emphasis on an option but not a requirement for backward comparability, suggesting more linked account facilities. Col. 11, line 16 discloses that credit accounts are available to the user in the context of the account linkage facilities of the Atkins disclosure, as well as other financial activities such as real estate (Col. 11, ll. 23-27) and why the Atkins disclosure would be attractive for banks to support and participate in. Such a motivation for financial institutions is also disclosed in Col. 8, ll. 51-61.

Regarding the argument that Atkins **teaches away** from the back-up facility for an insufficient funds scenario (page 18, ll. 10-11), Appellant again takes information disclosed in Atkins out of the context of the issue of obviousness adequacy of Atkins as if he were arguing against an anticipation rejection. Again, we are not dealing with an anticipation rejection.

Regarding Teaching Away, the MPEP gives guidelines for teaching away in **MPEP § 2141.02** and **MPEP § 2143.01**. Case law offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as expressed in the court's opinions in *W.L. Gore & Associates v. Garlock, Inc.*, and in *In re Gurley*, as follows:

(a) **W.L. Gore & Associates v. Garlock, Inc.** This (case) involves a teaching of "stretching said (unsintered) PTFE at a 10% per second rate to more than five times the original length. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE, would not have suggested rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly".

Having read this court opinion, the examiner concludes that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the

justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible and thus the teachings could not be properly combined. Thus the court followed common sense logic.

(b) The *In re Gurley* opinion offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as follows: A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “the nature of the teaching is highly relevant and must be weighed in substance (underlining added). A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant’s purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

To summarize, these two court opinions demonstrate that the concept of “teaching away” has technical foundations and requirements of a limited, narrow technical nature of a common sense variety.

In this case, it becomes clear that, contrary to Applicant’s assertion that Atkins teaches away, the fact that Atkins discloses various features not needed for Appellant’s invention is moot. There are no disclosures in Atkins which prohibit the modification of Atkins’ disclosures from being modified to meet Appellant’s limitations such as for an interface to a credit account or credit facility used to back up a cash account in the event of insufficient funds in the cash account. In Atkins, the user has the prerogative to set limits of various kinds for cash withdrawals and for conditions requiring explicit authorization. The Atkins disclosure involves directly analogous art to that of Applicant’s invention and the modifications would not disable Atkins’ teachings, since we are dealing with the software of a financial services system and method. Further, Atkins discloses a wide variety of options for the user which can include a plurality of accounts

and credit facilities and lines of credit. These are not mutually exclusive, and Atkins explicitly teaches use of the sweeps feature in a plurality of places and conditions (e.g. Col. 7, ll. 43-44; Col. 8, l. 43).

Argument C. 3. Neither Atkins Nor Schein Teaches or Suggests "performing sweeps of said at least one cash account at predetermined times to determine whether said at least one cash account contains sufficient funds to cover the charges incurred through use of the linked account instrument".

RESPONSE: It is again important to note that Appellant is arguing against rejections made under 35 USC 103(a) obviousness, not an anticipation rejection. In this situation, the exact, detailed use of various features which were obvious to the ordinary practitioner make moot such obvious differences between Appellant's invention and the prior art. Sweeps of accounts are taught explicitly in both Atkins and Schein, as noted above. The examiner has already established on the record a rational case for why sweeps performed in various patterns would have been obvious to the ordinary practitioner of the art at the time of Appellant's invention based on the disclosures of Atkins and Schein. The sweep schedules in the prior art of record are implicitly flexible, and can occur on a scheduled basis such as daily or on a real time basis. The original computers used in banking were main frames which operated under the batch system concept, thus limiting real time capabilities performed through computer automated systems. However, Atkins (e.g. Col. 7, ll. 43-44; Col. 8, l. 43) and Schein (admitted by Appellant on page 20, ll. 10-12) teach and/or suggest that sweeping has also been used in the art. Appellant attempts to deny that the Schein disclosure in this section somehow does not suggest and reinforce the wide use of account sweeping in the art. Such arguments, which Appellant uses throughout this section of argument, flies in the face of the *In re Kahn* decision on obviousness rejections cited above. An ordinary practitioner would have known that computer capabilities were such at the time of Appellant's invention to permit instant, on demand sweeping of accounts made possible by the real time capabilities of

computer systems proliferating in the financial services industry in the 1990's to enable real time transactions and the continued expansion of services and features to offer the consumer and commercial customer. At the same time, the real time computer systems do not prohibit scheduled sweeps. Therefore, Atkins and Schein, if anything, present more sophisticated and more flexible art than what is claimed by Appellant, which by no means disqualifies this prior art from serving as legitimate prior art for Appellant's invention.

ARGUMENT D. Independent Claim 24 is Patentable over Atkins and Schein.

RESPONSE: Independent claim 24 has been rejected with independent claim 1 throughout the prosecution of this application. The claimed limitations are similar, and Appellant's arguments are similar. The Board is referred to the examiner's comments regarding claim 1 above.

ARGUMENT E. Independent Claim 50 is Patentable over Atkins and Schein.

RESPONSE: Independent claim 50 is a variation of claim 1. Appellant's arguments against the rejection of claim 50 are made on similar grounds as Appellant's arguments against the rejection of claim 1. The Board is therefore referred to the examiner's responses to Appellant's arguments against the rejection of claim 1. First, Appellant refers to his rationale for arguing against the teachings or suggestions of a linked account instrument in regards to claim 1 (page 23, ll. 5-19). Secondly, Appellant briefly alleges that frequent withdrawals are discouraged by Atkins by pointing to a tangential section of two sentences in Atkins while ignoring all other flexible and voluminous feature options in Atkins. Such an allegation does not meet the standard of proof required for rebutting the examiner's obviousness rationale already placed on the record and repeated above. It also does not stand up to the teachings, suggestions and obvious conclusions which the ordinary practitioner of the art would have drawn from Atkins at the time of Appellant's invention.

ARGUMENT F. Independent Claim 51 is Patentable over Atkins and Schein.

RESPONSE: Independent claim 51 is a variation of claim 24 intended to enable the implementation of claim 50. Appellant's arguments against the rejection of claim 51 are essentially made on similar grounds as Appellant's arguments against the rejection of claim 24. The Board is therefore referred to the examiner's responses to Appellant's arguments against the rejection of claim 1. The Board is also referred to the examiner's general response above. The ordinary practitioner of the art at the time of Appellant's invention, in view of the disclosures of Atkins and Schein, would have seen it as obvious to draw funds from a linked back-up credit facility of a plurality of types until the cash account in question was replenished. Appellant again chooses irrelevant sections of Atkins to attempt to make a case of teaching away, as discussed above in regards to the rejection of claim 1, especially since Atkins teaches the coexistence of a multiplicity of features operable for a user as the user may choose. This demonstrates how flexible and compatible multiple computer software enabled features are.

ARGUMENT G. Dependent Claims 2-23 and 25-49 Are Each Separately Patentable Over Atkins and Schein.

RESPONSE:

1. Regarding patentability due to their dependency on claims 1 and 24 (p. 25, II. 10-16): This argument is invalid in view of the examiner's rejection arguments regarding these independent claims 1 and 24.

2. Re. Claims 2-3 and 25-25

Appellant alleges that Atkins and Schein "fail to disclose a "demand deposit account" as being backed by at least one credit account. In addition, there is no teaching or motivation to modify Atkins to include the feature of at least one demand deposit account." (page 25, II. 19-21). However, Appellant offers no credible rationale for discrediting the examiner's presentation of a potential motivation of the ordinary practitioner. Further, Appellant again argues a single detail in Atkins which ignores the wide ranging features disclosed and suggested in Atkins, as demonstrated by the examiner in the above claim rejections, in the general response and in the other responses above, particularly those regarding claim 1. For example, Appellant argues that Atkins "does not require inclusion

of a cash account much less a demand deposit account". That is an anticipation argument. The rejections are based on the 35 USC 103(a) obviousness statute. The obviousness teachings and suggestions for these features, combined with the knowledge of the ordinary practitioner as reiterated in the recent *In re Kahn* ruling, support the obviousness case based on Atkins and Schein.

3. Claims 9-16 and 32-39

ARGUMENT: "Claims 9 and 32 are each separately patentable because Atkins and Schein fail to disclose the generation of "individual automated clearing house debits" "for each transaction initiated with the linked account instrument." Atkins makes no reference to an automated clearing house debit. In fact, even if automated clearing house debits were contemplated, Atkins would refrain from generating *individual* automated clearing house debits for *each* transaction because Atkins disfavors frequent withdrawal from the asset accounts in its system. See e.g., Atkins, col. 13, 11. 55-59. Neither does Schein make any reference to an automated clearing house debit. Since claims 10-16 and 33-39 all depend from either claim 9 or claim 32, they are all patentable over Atkins and Schein for at least the same reasons. Further, since Atkins and Schein do not disclose or suggest any of the specific rules recited in claims 10-16 or 33-39 for processing the automated clearing house debits against the at least one cash account and the at least one credit account, each of these claims is separately patentable over Atkins and Schein." (page 26, ll. 1-13).

RESPONSE: First of all, the examiner's rejections pointed out that ACH transactions were inherent in Atkins. Secondly, Atkins in fact refers to the ACH system in Table 2-A1 and Table 21-2. Thirdly, an ordinary practitioner of the art at the time of Appellant's invention would have found it obvious that ACH transactions are operated by the banking system, not by a user or by an invention such as Appellant's. The ordinary practitioner would have known that certain ACH transaction are debits, and that each ACH debit is originated through an account at an ACH member bank, and that an ACH debit is created when a debit is transmitted from an account at one ACH member bank to an account at another ACH member bank. Therefore, ACH debits are implicit transaction components of the operation of the banking system. As such, the claimed

limitations come automatically with the banking system with certain transactions. Appellant can only trigger an ACH debit outside the institution he is connected to, and the ACH system automatically executes the transaction.

4. Claims 17-23 and 40-47

ARGUMENT: "Claims 17 and 40 are each separately patentable because Atkins and Schein fail to disclose a "daily limit" on a cash account against which individual transactions may be authorized. Atkins does not impose a daily limit on its user's spending or borrowing activities. Rather, Atkins provides a measure of security by imposing a loan to value ratio which is not a daily limit at all. See e.g., Atkins at col. 11, 11. 31-35; col. 16, 11. 38-44. Schein mentions line of credit in general but does not disclose a "daily limit" as presently claimed. Therefore, Atkins and Schein cannot render claims 17 or 40 obvious. Since claims 18-23 and 41-47 all depend from either claim 17 or claim 40, they are all patentable over Atkins and Schein for at least the same reasons. In addition, since Atkins does not disclose or suggest any of the additional limitations recited in claims 18-23 or 41-47, these claims are each separately patentable over Atkins." (page 26, l. 14 – page 27, l. 2).

RESPONSE: The critical element in this argument is the claimed daily limit limitation feature. Claims 17-23 and 40-47 rise and fall upon it, since claims 18-23 depend on claim 17, and claims 41-47 depend on claim 40. Appellant once again engages in an anticipation argument against an obviousness statute rejection by pointing to a particular feature in Atkins. The ordinary practitioner of the art at the time of Appellant's invention would have been fully cognizant of the ubiquitous use of daily limits by banks and even by banking customers. Both such parties have used a daily limit policy for cash withdrawals or even credit use as a protective device against inadvertent, unwise or criminal misuse of an account, thus as a protective device and having protective motivation. Based on such knowledge and awareness, an ordinary practitioner would have seen the implicit nature of this device in Atkins due to the rich options Atkins discloses and suggests throughout his teaching. Further, since Appellant also explicitly denies that Schein fails to disclose the use of daily limits, the same rationale applies to invalidate Appellant's argument about Schein. It is difficult to

imagine that the ordinary practitioner would not see this as implicit in Schein, who discloses what the world leader in this particular aspect of the art, Citibank, teaches and suggests through the recounting of the development of Appellant's invention through the leadership of Citibank since 1974. This art is so well known that even millions of ordinary users are familiar with features such as daily limits on a cash account in a bank account and in accounts which are backed up by a linked account instrument facility as defined by Appellant in the above mentioned specification. For example, the examiner personally had Citibank accounts and Wells Fargo Bank accounts in the 1990's. Each account had daily limits on the withdrawal of cash applied by each bank. Further, the examiner's Wells Fargo Bank checking account during this period of time had a Wells Fargo credit card account instrument as back-up to a checking account. Daily limits applied to the withdrawal of cash from either account. Daily limits also applied to the Citibank card account for cash withdrawals. This was true for any similar accounts the examiner has had with other banks at least since the 1980's.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reason that it is believed that the rejections should be sustained.

Respectfully submitted,

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